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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/076,335      | 02/14/2002  | Yvonne Watters Booth | AUS920010775US1     | 1983             |

7590

09/23/2004

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| EXAMINER |
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APPIAH, CHARLES NANA

| ART UNIT | PAPER NUMBER |
|----------|--------------|
|----------|--------------|

2686

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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OCT 04 2004

Technology Center 2600

# Office Action Summary

Application No.

10/076,335

Applicant(s)

BOOTH ET AL.

Examiner

Charles Appiah

Art Unit

2686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-20 are rejected under 35 U.S.C. 102(e) as being anticipated by **Cotichini et al. (6,300,863)**.

Regarding claims 1, 9 and 15 Cotichini discloses a method, a system and a program product for tracing an electronic device transmitting identifying indicia over a global network, the electronic device connectable to a network server through the global network (see Figs. 1 and 7B), the method comprising the steps of: determining identifying indicia for the electronic device that are transmitted by the electronic device during communications over the global network (see col. 10, lines 15-26, col. 11, lines 32-50), automatically monitoring communications over the global network to identify

data transmitted through the global network to identify data transmitted through the global network that contains the identifying indicia (see col. 11, line 65 to col. 12, line 4), and upon identification of data transmitted through the global network that contains the identifying indicia, determining the location of the electronic device by tracing the source of the identifying indicia within the global network (see col. 12, lines 4-18).

Regarding claims 2, 10, and 16 Contichini further discloses wherein the global network includes Internet (see Internet application, col. 11, lines 32-32-34).

Regarding claims 3, 11, and 17 Contichini further discloses determining the identifying indicia by extracting the identifying indicia from data previously transmitted by the electronic device and stored on the global network (see col. 11, lines 51-64).

Regarding claims 4, 12, and 18, Contichini further discloses wherein the indicia is the MAC address of the electronic device (see col. 16, lines 37-42).

Regarding claims 5 and 13, Contichini further discloses wherein the identifying indicia is determined by indexing a known host name or IP address of the electronic device contained within data previously transmitted by the electronic device and stored on the global network (see col. 11, lines 51-64).

Regarding claim 6, Contichini further discloses providing the network server with one or more global network communication links used to enable transmission between the electronic device and the network server, wherein the transmission via the communication links is used for determining the location of the electronic device (see col. 16, lines 53-65).

Regarding claims 7, 14 and 19 Contichini further discloses entering the identifying indicia into a database stored in the network server and performing a matching function on the network server that compares the data transmitted over the global network with the database to identify transmitted data containing the identifying indicia (see col. 26, lines 48-62).

Regarding claims 8 and 20, Contichini further discloses that upon identification of data transmitted through the global network that contains the identifying indicia, notifying a responsible party that data transmitted through the global network contains the identifying indicia (see col. 27, lines 8-34).

### ***Conclusion***

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Koodli (6,571,095) discloses a system for providing address discovery of services in mobile networks.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Appiah whose telephone number is 703 305-4772. The examiner can normally be reached on M-F 7:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marsha Banks-Harold can be reached on 703 305-4379. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2686

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

CA  
September 20, 2004

  
**CHARLES APPIAH**  
**PRIMARY EXAMINER**

|                                   |                                       |  |             |
|-----------------------------------|---------------------------------------|--|-------------|
| <b>Notice of References Cited</b> | Application/Control No.<br>10/076,335 | Applicant(s)/Patent Under<br>Reexamination<br>BOOTH ET AL. |             |
|                                   | Examiner<br>Charles Appiah            | Art Unit<br>2686   | Page 1 of 1 |

**U.S. PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Name             | Classification |
|---|---|--|-----------------|------------------|----------------|
|   | A | US-6,300,863                                     | 10-2001         | Cotichini et al. | 340/5.8        |
|   | B | US-6,571,095                                     | 05-2003         | Koodli, Rajeev   | 455/435.1      |
|   | C | US-  |                 |                  |                |
|   | D | US-  |                 |                  |                |
|   | E | US-  |                 |                  |                |
|   | F | US-  |                 |                  |                |
|   | G | US-  |                 |                  |                |
|   | H | US-  |                 |                  |                |
|   | I | US-  |                 |                  |                |
|   | J | US-  |                 |                  |                |
|   | K | US-  |                 |                  |                |
|   | L | US-  |                 |                  |                |
|   | M | US-  |                 |                  |                |

**FOREIGN PATENT DOCUMENTS**

| * |   | Document Number<br>Country Code-Number-Kind Code | Date<br>MM-YYYY | Country | Name | Classification |
|---|---|--|-----------------|---------|------|----------------|
|   | N |  |                 |         |      |                |
|   | O |  |                 |         |      |                |
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|   | Q |  |                 |         |      |                |
|   | R |  |                 |         |      |                |
|   | S |  |                 |         |      |                |
|   | T |  |                 |         |      |                |

**NON-PATENT DOCUMENTS**

| * |   | Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages) |
|---|---|---|
|   | U |   |
|   | V |   |
|   | W |   |
|   | X |   |

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.